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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,162	11/21/2003	Jacob Lahijani	FL0233USNA	2357

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EXAMINER
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FLETCHER III, WILLIAM P

ART UNIT	PAPER NUMBER
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1792

NOTIFICATION DATE	DELIVERY MODE
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09/09/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-Legal.PRC@usa.dupont.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/719,162	<b>Applicant(s)</b> LAHIJANI, JACOB	
	<b>Examiner</b> William P. Fletcher III	<b>Art Unit</b> 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-13 is/are pending in the application.
- 4a) Of the above claim(s) 9-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 4-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 25, 2008, has been entered.

### ***Response to Amendment***

2. Claims 1 and 4-13 remain pending.

### ***Election/Restrictions***

3. Claims 9-13 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 8, 2006.

### ***Response to Arguments***

4. Applicant's arguments filed July 25, 2008, have been fully considered but they are not persuasive.

A. As an initial point, the Examiner disagrees with Applicant's assertion that Wu fails to disclose TFE/PEVE. Wu clearly teaches co-polymers of TFE with "...CF<sub>2</sub>=CFOR<sub>f</sub> (per)fluoroalkylvinylethers (PAVE), wherein R<sub>f</sub> is a C<sub>1</sub>-C<sub>6</sub> (per)fluoroalkyl, for example CF<sub>3</sub>, C<sub>2</sub>F<sub>5</sub>, C<sub>3</sub>F<sub>7</sub>..." [2:46-48]. It is the Examiner's

position that the where  $R_f$  is a  $C_2$  (per)fluoroalkyl,  $C_2F_5$ , this reads on the claimed perfluoroethylvinylether.

B. With respect to the combination of Wu and JP '593, Applicant argues that it would not have been obvious to include metal powder in the composition of Wu in order to prevent bubbling since Wu has already "solved the problem" of bubbling. The Examiner disagrees. There is no invention in combining old elements in such a manner that these elements perform in combination the same function as set forth in the prior art without giving unexpected results. See *In re Rose*, 105 USPQ 237. In other words, a new combination of old elements *may* be patentable, but it must amount to invention and the elements *must* cooperate to produce new, unobvious, and unexpected results. See *In re Lindberg*, 93 USPQ 23, 194 F2d 732 (CCPA 1952).

C. While Applicant asserts unexpected results, based on the Examples 1 and 2 in the instant specification, this evidence is not commensurate in scope with the claimed invention. Independent claim 1 broadly recites "metal powder," while the examples involve only the specific metals Zn, Cu, and Sn. Further, claim 1 broadly recites a concentration of 0.2 to 2 wt.-% of this powder, while superior results are demonstrated for only a 1 wt.-% concentration of Zn powder. Consequently, these results do not weight against the *prima facie* case of record, in which JP '593 teaches an overlapping concentration of 0.1-30 wt.-%.

D. Further, Applicant asserts that "...if '593 obtained adhesion of the lining, this unusual result would have been disclosed." This argument from silence is mere conjecture and does not weigh against the *prima facie* case of record.

E. With respect to claim 7, the Examiner disagrees with Applicants assertion and maintains that there is at least one layer applied in which a powder is dispersed in the resin.

F. With respect to claim 8, polymer stabilization is performed for reasons other than suppressing bubbles during melt-processing such as increasing shelf-life. It is well-settled that the prior art need not disclose the same purpose for a claimed method in order to establish its obviousness under 35 USC 103. See *In re Dillon*, 919 F2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990), *cert. denied*, 500 US 409 (1991). The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1 and 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al. (US 6,624,269 B2) in view of JP 2904593 B2 (cited by Applicant).

A. These claims are rejected for the same reasons set forth under this heading in the prior Office action.

B. With respect to the claims as amended:

i. Claim 1

In the first full paragraph at page 5 of the remarks, Applicant admits that Wu's particles have the same sphere factor as claimed.

Further, the range of 0.2-2 wt.-% remains encompassed by the range of 0.1-30 wt.-% disclosed by JP '593.

ii. Claim 7

The Examiner disagrees with Applicants assertion and maintains that there is at least one layer applied in which a powder is dispersed in the resin.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Sunday, 5:00 AM - 12:00 PM and Monday through Friday, 5:00 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1792

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/William Phillip Fletcher III/**

Primary Examiner

September 2, 2008